THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
_____

Ex parte PAUL C. HECKEL
and CHARLES H. CLANTON[1]
_____

Appeal No. 96-1928
Application 07/504,679[2]
_____

ON BRIEF
_____

Before THOMAS, KRASS and MARTIN, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

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[1] In accordance with the examiner's footnote at the bottom of the first
page of the Examiner's Answer dated April 28, 1995, the inventorship of this
reissue application has been changed.

[2] Application for patent filed April 4, 1990, for Reissue of Patent No.
4,736,308, granted April 5, 1988; based on Application 06/754,512, filed July
10, 1985, which, according to appellants, is a continuation-in-part of
Application 06/647,649, filed September 6, 1984, now abandoned.

Appellants have appealed to the Board from the examiner's

final rejection of what appears to us to be claims 1-3, 5-7,

9, 12, 13, 15, 16, 18, 20, 23, 24, 26, 27, 33, 43, 54, 55, 71,

72, 75, 76, 79-91, 95, 98-117, and 120-142, 144, 145 and 147-

158.

Representative claim 95 is reproduced below:

95.   In a process executed in a computer with a data
display screen and strings of alphanumeric characters stored
in one or more files, a method for displaying the strings in
an area of the data display screen allocated to the process
for display, said allocated area containing a first display
area comprised of a plurality of lines, each said string
having a plurality of fields of alphanumeric characters,
comprising the steps of:

(a) fetching first and second strings from said one or
more files;

(b) simultaneously displaying on the data display screen
portions of a plurality of preselected fields of the first
string at a specified position on said lines so that portions
of a plurality of fields are displayed on one line of the
first display area, further wherein only one instance of each
portion of a field is displayed within said first display area
of the allocated area and portions of preselected fields of
the second string within a second display area within the
allocated area wherein at least one character is removed from
one of said fields of the first string to generate one of said
portions of the first string and,

(c) in response to input from an input device displaying
within said allocated display area all of the characters of
said field from which a character was removed while
maintaining the display of at least some portions of said

<u>first and second string displayed in the same positions as
displayed in step (b)</u>.

The following references are relied on by the examiner:

Heckel   4,486,857   Dec. 4,
1984
                                          (filed Oct. 6, 1982)
Vincent et al. (Vincent)   4,645,238   Feb.
24, 1987
                                          (filed Apr. 21, 1983)
LisaList Manual, Apple Computer, Inc.   (Copyright
1983)

In accordance with the supplemental examiner's answer,

Paper No. 53, dated March 6, 1996, and the additional

communication from the examiner identified as Paper No. 64,

dated June 16, 1998, any and all outstanding rejections under

35 U.S.C. § 251 of the claims on appeal have been withdrawn by

the examiner.

Of those claims listed earlier in this opinion believed

by us to be the claims on appeal, the examiner has set forth

rejections of each of them under 35 U.S.C. § 103.   The

examiner considers the following claims obvious in light of

the teachings of Vincent and Heckel: claims 1, 2, 6, 12, 15,

16, 18, 20, 23, 24, 27, 75, 81, 95, 98, 99, 102, 103, 104,

105, 111-113, 120, 121, 141 and 142. To reject the following

claims the examiner adds to this basic combination of

references LisaList:

claims 3, 5, 7, 9, 13, 26, 33, 43, 54, 55, 71, 72, 76, 79, 80,

82, 83, 85-91, 100, 101, 106-110, 114-117, 123-127, 128-140,

144, 145, 147-158. These rejections are set forth at page 3

of the initial examiner's answer dated April 28, 1995. As to

the second rejection, the examiner does not explicitly include

here a rejection of claim 122, although it is expressed at

page 7 of answer. The bottom of page 10 of this answer

reveals the examiner's intent to reject claims 79-91 under 35

U.S.C. § 103 including claims 84, 87, 88, 89 and 90, although

it is not clear under which rejection of the stated rejections

the examiner intends to reject these latter claims. In any

event, based upon our decision, this question is moot.

     Rather than repeat the positions of the appellants and

the examiner, reference is made to the briefs and the answers

for the respective details thereof.

<div align="center">OPINION</div>

     Generally for the reasons expressed by appellants in the

initial portions of the brief and reply brief dealing with the

combinability issue of the two major references, Vincent and

Heckel, and excluding the reasoning advanced by appellants

that Vincent teaches away from the combination, we reverse the

examiner's initial stated rejection under 35 U.S.C. § 103 and,

as such, the second stated rejection under 35 U.S.C. § 103

involving LisaList to reject additional claims.

From our detailed study of Vincent and Heckel, we find

ourselves in general agreement with these assertions made by

appellants in the brief and reply brief respectively:

> The Examiner's prima facie case is defective.
> The Examiner asserts without basis that Vincent not
> being able to selectively expand fields is a
> limitation of Vincent. Vincent makes no suggestion
> that this is a limitation and the Examiner provides
> no basis to suggest it is. As Vincent has the
> capability with its <u>Day Screen</u> to expand and display
> in full all fields simultaneously, there is no there
> is no [sic] motivation to <u>selectively</u> expand fields.
>
> When considered as a whole, Vincent teaches the <u>non-
> selectively</u> expanding the display field.
> Specifically, it teaches the <u>Day Screen</u> (Fig. 2)
> which simultaneously displays <u>all</u> of the fields <u>in
> full</u> including those compressed down to a single
> character and the NOTE field which may only be
> "partially" shown.
> Thus Vincent's solution to the problem of showing
> compressed fields is to display all fields at once.
> Vincent's solution is a different solution to a
> different field expansions problem from that taught
> in the `857 patent. The Examiner asserts without
> any basis that Vincent has a limitation which which

[sic] requires <u>selectively</u> expanding the fields.
The Examiner never says why <u>selective</u> expansion is
desirable or what problem it solves that is not
already solved by Vincent's <u>Day Screen</u> display of
all fields fully expanded. Vincent's solution
appears to work fine and be complete. [Principal
Brief on appeal, February 15, 1995, pages 13-14].

In fact, the combination does make the system
more complex, but does not solve any problem that
<u>Vincen</u>t recognized. The problem that Vincent states
he is solving is to automatically generate the
month-at-a-glance screens from the day screen
without the user having to enter the information
twice. Appellant cannot find anywhere that <u>Vincent</u>
suggests the issue addressed by <u>Heckel</u> `857 -- the
ability to display a single record containing more
characters than can be displayed on a display screen
at one time -- is a problem. It appears that the
Examiner with hindsight has manufactured a problem
that does occur in <u>Vincent</u> to justify the
combination. Indeed, <u>Vincent</u> states this as a
virtue of their invention is that "The advantages of
these advances are that screen size does not have to
be increased" (<u>Vincent</u>: col. 2, lines 32-33).
Lacking a recognized problem, there is no incentive
to combine. [Reply Brief, July 3, 1995, pages
3 and 4].

Taking representative claim 95 as an example, the

examiner, at page 4 of the initial answer of April 28, 1995,

indicates that Vincent fails to teach certain aspects of this

claim. The examiner makes reference to column 1, lines 47-67

of Vincent allegedly isolating various deficiencies in this

reference. The examiner's view as to this column 1 portion of

Vincent, as expressed at page 12 of this answer as well as

pages 2 and 3 of the supplemental answer dated November 30,

1995, asserts that Vincent explicitly states that switching

the month screen to the day screen to see the missing

information is not efficient. The examiner's reasoning in

both answers appears to assert that Vincent fails to

completely solve the problem by failing to address the

situation when the length of the note information, apparently

in the month display screen in Figure 1 of Vincent, is longer

than the note display field as a basis for asserting that

Heckel's teachings would have remedied this deficiency.

    We do not agree with this reasoning process of the

examiner.

Indeed, column 1 background assessment identified by the

examiner in Vincent is Vincent's assessment of the prior art

to him, whereupon the disclosure in Vincent's patent appears

to us to be directed at curing any known problems to him. We

do not regard Vincent's discussion in the written description

portion of his patent as indicating that any deficiencies

remain or any unsolved problems remain among those he has

chosen to provide solutions to his own assessment of the prior

art to him. The examiner's argumentative approach appears to

be a cloak for prohibited hindsight analysis. We are in basic

agreement therefore with appellants' earlier noted assessment

of Vincent's teachings and showings alone. We reach a similar

conclusion with respect to the examiner's statement of the

rejection of the other independent claims in other pages of

the principal examiner's answer.

The principal focus of Vincent is calendaring, not

generic data structures, as in Heckel, even though Vincent

does teach data structures for annotating daily and monthly

calendaring of events. Even if Vincent were found by the

artisan to have been deficient in some way or would have found

it desirable to modify Vincent in some way, a more simplified

and direct approach would have been more obvious to us than

the hindsight analysis proffered by the examiner to rely upon

Heckel's teachings and suggestions. If, as asserted by the

examiner, Vincent fails to completely solve problems stated by

him with respect to the prior art to him by failing to address

the situation when the length of the note on the month

calendar is longer than the note display field, and even if

such were independently realized by the artisan with respect

to Vincent's own teachings and suggestions, we find that it

would have been obvious to the artisan to have utilized

smaller print or smaller size day boxes in the month calendar

or abbreviations for the note data in an effort to accommodate

the note field at the bottom of the calendaring page and

expand it to include more data or to lengthen fields or to

permit more notes to be derived from the Figure 2 showing of

the individual day page. Vincent already teaches, for

example, the use of abbreviations and key symbols in deriving

each day box in the monthly calendar in Figure 1 from the

individual day display in Figure 2. Following these ideas in

our view is more consistent with approaches users of calendars

normally have undertaken generally, particularly those types

of calendars utilized by people for daily and monthly

scheduling of events to permit an expanded note field.

We characterize in another manner the examiner's approach

as being that, from the examiner's view the artisan <u>could have</u>

<u>modified</u> Vincent in light of Heckel's teachings to provide

expanded calendaring of events. This "could have modified"

approach is not sufficient within 35 U.S.C. § 103. However,

we

remain unconvinced from the collective teachings and

suggestions of Heckel and Vincent as well as the examiner's

reasoning that

it would have been obvious within 35 U.S.C. § 103 to have so

modified Vincent's teachings and suggestions in light of

Heckel.

We do not agree with the examiner's basic view that the

artisan would have reasonably, prospectively viewed the

combination of teachings and suggestions of Vincent and Heckel

in such a manner as to render obvious the subject matter of

the claims stated in the initial rejection on appeal. In a

similar manner, we remain unconvinced of the obviousness of

combining the additional teachings of LisaList to these two

references to reject the claims identified by the examiner in

the second rejection under 35 U.S.C. § 103.

In view of the foregoing, we have reversed both

rejections under 35 U.S.C. § 103 of all claims on appeal.

<u>REVERSED</u>

                    JAMES D. THOMAS   )
                    Administrative Patent Judge   )
)
)
)
                    ERROL A. KRASS   ) BOARD OF
PATENT
                    Administrative Patent Judge   )   APPEALS AND
)   INTERFERENCES
)
)
                    JOHN C. MARTIN   )
                    Administrative Patent Judge   )

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